Supreme Court, U. S.
FILED
SEP 29 1975
MICHAEL RODAK, JR., CLERK

Supreme Court of the United States

October Term, 1975
No. 75-489

LAWRENCE R. SPERBERG,
Petitioner,

vs.

THE GOODYEAR TIRE & RUBBER COMPANY, THE FIRESTONE TIRE & RUBBER COMPANY, THE GENERAL TIRE & RUBBER COMPANY and B. F. GOODRICH COMPANY,
Respondents.

PETITION FOR A WRIT OF CERTIORARI
To the United States Court of Appeals
For the Sixth Circuit

PAUL A. WEICK
WEICK & GENOVESE CO., L.P.A.
800 Centran Building
Akron, Ohio 44308
Counsel for Petitioner

THE GATES LEGAL PUBLISHING CO., CLEVELAND, OHIO—TEL. (216) 621-5647

TABLE OF CONTENTS

TABLE OF AUTHORITIES III
OPINIONS BELOW 2
JURISDICTION 2
QUESTIONS PRESENTED 3
STATUTES INVOLVED 3
STATEMENT OF THE CASE 3
REASONS FOR GRANTING THE WRIT 7

1. In a Patent Infringement Suit 35 U.S.C. 282 Places the Burden of Proof on the Issue of Patent Validity on the Party Asserting Invalidity 7
2. 35 U.S.C. 282 Does Not Permit Jury Instructions Which Place the Burden of Proof of Patent Validity Upon the Patentee in a Patent Infringement Suit in the Absence of a Clarifying Instruction That Such Burden Is Met by the Introduction Into Evidence of the Duly Issued Patents 11

CONCLUSION 14
APPENDIX A1

A. Opinion of the United States Court of Appeals for the Sixth Circuit A1
B. Judgment of the United States Court of Appeals for the Sixth Circuit in Sperberg v. Goodyear Tire & Rubber Company A15
C. Judgment of the United States Court of Appeals for the Sixth Circuit in Sperberg v. Firestone Tire and Rubber Company A16
D. Judgment of the United States Court of Appeals for the Sixth Circuit in Sperberg v. General Tire & Rubber Company A17

E. Judgment of the United States Court of Appeals for the Sixth Circuit in Sperberg v. B. F. Goodrich Company A18
F. Order of the Court of Appeals Denying Motion to Consolidate Appeals A19
G. Judgment of the United States District Court for the Northern District of Ohio, Sperberg v. Goodyear Tire & Rubber Company A21
H. Judgment of the District Court, Sperberg v. Firestone Tire and Rubber Company A22
I. Judgment of the District Court, Sperberg v. General Tire & Rubber Company A23
J. Judgment of the District Court, Sperberg v. B. F. Goodrich Company A24
K. Order of District Court Denying a New Trial A25
L. 35 U.S.C. 282 ..... A26
M. Act of March 3, 1897, ch. 391, sec. 2, 29 Stat. 692 (repealed 1952) A27
N. Federal Rules of Evidence, Rule 301 ..... A29

TABLE OF AUTHORITIES

Cases

Ayers v. Watson, 113 U.S. 594 (1885) 14
Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation, 402 U.S. 313 (1971) 8
Commercial Molasses Corp. v. New York Tank Barge Corp., 314 U.S. 104 (1941) 9
Del Vecchio v. Bowers, 296 U.S. 280 (1935) 9
Henry v. Collins, 280 U.S. 356 (1965) 14
Hobbs v. United States Atomic Energy Commission, 451 F.2d 849 (5th Cir. 1971) 10
Ingersoll-Rand Co. v. Brunner & Lay, Inc., 474 F.2d 491 (5th Cir. 1973), *reh. denied*, 474 F.2d 1347, *cert. denied*, 414 U.S. 865 10
Long v. Arkansas Foundry, 247 F.2d 366 (8th Cir. 1957) 10
Mobile, Jackson & Kansas City R.R. Co. v. Turnipseed 219 U.S. 35 (1910) 9
Moon v. Cabot Shops, Inc., 270 F.2d 539 (9th Cir. 1959), *cert. denied*, 361 U.S. 965 ..... 10, 11
Mumm v. Jacob E. Decker & Sons, 301 U.S. 168 (1937) 11, 14
New York Life Insurance Co. v. Gamer, 303 U.S. 161 (1938) 9, 14
Radio Corp. of America v. Radio Engineering Laboratories, Inc., 293 U.S. 1 (1934) 11, 14
Rains v. Niaqua, Inc., 406 F.2d 275 (2nd Cir. 1969) 10
Strong-Scott Manufacturing Co. v. Weller, 112 F.2d 389 (8th Cir. 1940) 11

Statutes

Act of March 3, 1897, ch. 391, sec. 2, 29 Stat. 692 (repealed 1952) 3
Federal Rules of Evidence, Rule 301 .....3, 8, 9
35 U.S.C. 282 .....3, 6, 7, 8, 9, 10, 11, 13, 14, 15

Other

Senate Report No. 1979, 82nd Congress, 2nd Session, June 27, 1952, *U.S. Code Cong. & Adm. News* 2393 (1952) 10
Supreme Court's Proposed Rules of Evidence for United States Courts and Magistrates, Rule 301 9

Supreme Court of the United States

October Term, 1975

No. .....

LAWRENCE R. SPERBERG,
Petitioner,
vs.
THE GOODYEAR TIRE & RUBBER COMPANY,
Respondent.

LAWRENCE R. SPERBERG,
Petitioner,
vs.
THE FIRESTONE TIRE & RUBBER COMPANY,
Respondent.

LAWRENCE R. SPERBERG,
Petitioner,
vs.
THE GENERAL TIRE & RUBBER COMPANY,
Respondent.

LAWRENCE R. SPERBERG,
Petitioner,
vs.
B. F. GOODRICH COMPANY,
Respondent.

PETITION FOR A WRIT OF CERTIORARI
To the United States Court of Appeals
For the Sixth Circuit

Lawrence R. Sperberg, the petitioner herein, prays that a Writ of Certiorari issue to review the judgment of the United States Court of Appeals for the Sixth Circuit entered in the above causes on July 3, 1975.

OPINIONS BELOW

The opinion of the United States Court of Appeals for the Sixth Circuit in appeal #74-2063, *Sperberg v. Goodyear Tire & Rubber Company,* not yet reported, is reprinted in Appendix A. The judgment of the Court of Appeals in that appeal is reprinted in Appendix B. Opinions were not given by the Sixth Circuit in appeals #74-2064, *Sperberg v. The Firestone Tire & Rubber Company*; #74-2065, *Sperberg v. The General Tire & Rubber Company* and #74-2066, *Sperberg v. B. F. Goodrich Company,* rather judgments in those causes were rendered in accordance with the opinion in *Sperberg v. The Goodyear Tire & Rubber Company.* The judgments so rendered are reprinted as Appendices C, D, and E respectively. The order of the Sixth Circuit denying petitioner's motion to consolidate the above causes for purposes of appeal is reprinted as Appendix F.

The judgments entered by the United States District Court for the Northern District of Ohio in the four causes are reprinted as Appendices G, H, I, and J. The order of May 22, 1974 denying petitioner's motion for a new trial is reprinted as Appendix K.

JURISDICTION

The judgment of the United States Court of Appeals for the Sixth Circuit was entered in the several appeals on July 3, 1975. The jurisdiction of this Court is invoked under 28 U.S.C. 1254 (1).

QUESTIONS PRESENTED

1. Does 35 U.S.C. 282 place the burden of proof on the issue of patent validity on the party asserting invalidity, in a patent infringement suit?

2. Does 35 U.S.C. 282 permit jury instructions which place the burden of proof of patent validity upon the patentee in a patent infringement suit in the absence of a clarifying instruction that such burden is met by the introduction into evidence of the duly issued patents?

STATUTES INVOLVED

This petition involves interpretation of 35 U.S.C. 282. Because of the length of that statute its text is reprinted in full in Appendix L rather than in the body of this petition. Act of March 3, 1897, ch. 391, sec. 2, 29 Stat. 692 (repealed 1952), the predecessor of 35 U.S.C. 282, is reprinted in Appendix M for comparison purposes. Federal Rules of Evidence, Rule 301 is reprinted in Appendix N for the Court's convenience.

STATEMENT OF THE CASE

These causes were instituted by petitioner for infringement of United States Patent Nos. 3,563,088 and 3,722,270. The patents represent petitioner's discovery of a non-destructive method of determining the durable life and wear susceptibility of tires. Basically petitioner developed

a simple method for classifying tires by using a force variation machine in a new and novel way.[1]

The patents call for taking a series of like tires from a population or production run. Such tires are examined on the force variation machine for their radial and/or lateral force variations. The examined tires are then subjected to wear or actual failure tests in a controlled wear and/or durability test. The relationship between force variation and the rate of wear and/or durability is simply determined and all such information is collected. The collected material is used to provide a dictionary of stored terms so that other tires of the same population or a like population may be placed on the force variation machine and the force variation of that tire compared against the dictionary to determine the service potential for that tire.

The classifications arising from petitioner's invention find many uses, ranging from facilitating research and development of tires to aiding the consumer in the selection of a tire for personal use. By use of petitioner's invention the tire companies could for the first time issue forty thousand mile guarantees upon their tires with reasonable assurance that the warranty could be achieved. They could also determine which tires should be classified as scrap tires as well as the various gradations for trade sales in between.

---

1. The force variation machine has been in use by the tire industry for a number of years. The patents represent invention of a new way to use the machine rather than invention of the machine itself. In common use the force variation machine measures the non-uniformity of individual tires. It distinguishes between "square" and round tires with all gradations between. Results are expressed as pound units of force variation fluctuating around an average during one tire revolution.

Upon learning through trade articles that the rights granted him by the United States Government were being infringed petitioner sought legal redress in the United States District Court for the Northern District of Ohio. Suit was first instituted on October 5, 1972 as a class action against all of those utilizing petitioner's invention.

After the court ruled that the suit could not be maintained as a class action petitioner commenced four separate suits in the United States District Court for the Northern District of Ohio against the four respondents alleging infringement of patent Nos. 3,563,088 and 3,722,270.

The parties to the separate actions stipulated and agreed that the *Goodyear* case, Civil Action No. C73-801, would be tried first and further that all parties would be bound, subject to all rights of appeal, by the judgment in that case upon the issues of validity and enforceability of the patents in question. Firestone further agreed to be bound by the District Court's judgment in Case No. C73-801 on the issue of infringement. Such stipulation was approved by the District Court.

The *Goodyear* case was tried to a jury of six. In its instructions to the jury, the District Court assigned petitioner the burden of proving by a preponderance of the evidence that his patents were valid. The judge further charged on the presumption of patent validity and assigned respondent the burden of proving invalidity. Never, however, were any instructions given which were equivalent to a retraction of the burden erroneously assigned to petitioner. Never was the apparent inconsistency of two opposite affirmative burdens of proof explained to the jury.

Petitioner requested the additional explanatory instruction that his burden of proof on validity was satisfied by the presumption of patent validity, in the absence of

clear and convincing evidence to the contrary. Such requested instruction was refused by the court.

Although it found that the basic independent claims of both patents were both novel and useful and non-obvious, the jury found both patents in the suit to be invalid. Judgment was entered on April 25, 1974 dismissing the petitioner's complaint against Goodyear. On April 30, 1974 petitioner's complaints against the other three respondents were dismissed in accordance with the parties' pre-trial stipulation. Motions for a new trial in each case were timely made and overruled. Petitioner took appeal from each judgment to the United States Court of Appeals for the Sixth Circuit.

Petitioner's motion to consolidate the several cases on appeal was denied by the Sixth Circuit. The Court of Appeals instead ordered that it would enter appropriate judgments in the *Firestone, General* and *Goodrich* appeals upon determination of the appeal in the *Goodyear* case.

On appeal the Sixth Circuit affirmed the judgment of the District Court. It found no error in the jury instructions. In fact, the Court of Appeals in its opinion stated that petitioner did indeed have the burden of proving that his patents were valid. It explained that the presumption of patent validity is nothing more than a procedural tool which places upon the party asserting invalidity the burden of offering evidence sufficient to justify a finding of invalidity. As to both of these points of law the Sixth Circuit is in error.

It is petitioner's contention that 35 U.S.C. 282 places the burden of proof on the issue of patent validity upon the party asserting invalidity; that if such burden is wrongfully assigned to the patentee, nothing short of clear and unequivocal retraction will suffice to give 35 U.S.C. 282 its intended effect.

Petitioner believes that the Court of Appeals for the Sixth Circuit has not only sanctioned a departure by a district court, but has itself departed from clear congressional intent upon the important but unsettled issue of proof of patent validity. It is because this issue is so vital to patent litigation and to litigation wherever Congress has assigned a burden of proof, that petitioner prays that this court issue a Writ of Certiorari to review the judgment of the Sixth Circuit and to resolve this problem upon which this Court has yet to rule.

REASONS FOR GRANTING THE WRIT

The novelty and importance of the questions presented relating to the interpretation of the patent laws of the United States requires a brief discussion as to the reasons why each of said questions on which review is sought merits consideration and decision by this Honorable Court.

1. IN A PATENT INFRINGEMENT SUIT 35 U.S.C. 282 PLACES THE BURDEN OF PROOF ON THE ISSUE OF PATENT VALIDITY ON THE PARTY ASSERTING INVALIDITY.

At trial the United States District Court for the Northern District of Ohio charged the jury that petitioner had the burden of proving his patents valid. The Court said:

> "Thus, in this case the burden of proof is upon the plaintiff to prove, by a preponderance of the evidence, his assertions that:
>
> 1. U.S. Patent Nos. 3,563,088 and 3,722,270 are valid patents; and . . ."

On appeal the United States Court of Appeals for the Sixth Circuit affirmed this charge. The Sixth Circuit said:

> "The fact is that the plaintiff had the burden of proving the validity of his patent."

35 U.S.C. 282 apparently provides to the contrary:

> "A patent shall be presumed valid. . . . The burden of establishing invalidity of a patent shall rest on a party asserting it."

The United States Supreme Court has never ruled upon the exact effect of this statutory presumption of validity nor upon the nature of the burden assigned the party asserting invalidity.

In *Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation*, 402 U.S. 313, 335 (1971) this Court did say that patentees as a class of litigants are highly favored by the statute and that the defendant in an infringement suit would have to introduce proof to overcome the presumption of validity. That decision, however, did not shed any light upon the vital question of the quantum of proof necessary to overcome the presumption or the nature of the burden which the presumption assigns.

In the appended opinion, the United States Court of Appeals for the Sixth Circuit relegates the presumption of patent validity to a function quite like the presumptions described in Rule 301 of the Federal Rules of Evidence. The Sixth Circuit explains that the presumption of patent validity is one that serves to place the burden of proof on the party who asserts invalidity but falls out of the case when the party against whom the presumption works meets his burden of offering evidence sufficient to justify a contrary finding. In other words, the Sixth Circuit contends that the presumption of patent validity merely assigns the party asserting invalidity, the burden of going forward with evidence to rebut or meet the presumption.

This type of presumption, commonly characterized as a weak presumption, operates, however, only to control a directed verdict. The prima facie case it creates merely requires the court to direct a verdict in default of evidence offered by the party against whom the presumption operates. *Mobile, Jackson & Kansas City R.R. Co. v. Turnipseed*, 219 U.S. 35, 43 (1910). Because such a presumption drops from the case when sufficient evidence to support a contrary jury finding is introduced, it has no effect upon allocation of the burden of persuasion whatsoever. *See Commercial Molasses Corp. v. New York Tank Barge Corp.*, 314 U.S. 104, 111-113 (1941); *New York Life Insurance Co. v. Gamer*, 303 U.S. 161, 171 (1938); *Del Vecchio v. Bowers*, 296 U.S. 280, 285-286 (1935).

Thus if the Sixth Circuit's interpretation of the presumption of patent validity is to be followed, Congress has simply assigned the party asserting invalidity, the burden of introducing evidence that to the judges satisfaction is sufficient to support a jury finding on invalidity. Under the Sixth Circuit's analysis, the burden of persuading the jury that the patents are valid never leaves the patentee. The Sixth Circuit has obviously ignored the unequivocal language contained in 35 U.S.C. 282 which not only creates a presumption of validity but also assigns the burden of *establishing* invalidity to the party asserting it.

Rule 301 of the Supreme Court's Proposed Rules of Evidence for United States Courts and Magistrates recognized that a presumption may serve the function of assigning the party against whom it is directed the burden of *persuading* the trier of fact to the contrary of the presumed

fact. This is commonly referred to as a strong presumption. Even the Federal Rules of Evidence, Rule 301, as enacted allows for such a function where Congress so provides.

The clear intent behind 35 U.S.C. 282 is to create a a strong presumption which stands in sharp contradistinction to the type of presumption recognized by the Sixth Circuit. The strong presumption assigns the risk of non-persuasion on the issue of patent validity to the party asserting invalidity.[2] The statute says not that the burden of going forward with evidence of invalidity shall rest upon the party asserting it, but that the burden of *establishing* invalidity shall rest on the party asserting it. The presumption assigns the party asserting invalidity the burden of persuading the trier of fact that the patents are invalid, rather than the mere burden of going forward with evidence of invalidity.

Congress did not intend that the patentee should bear the ultimate burden of proof on the issue of validity while the party asserting invalidity need merely introduce some evidence of invalidity. A reading of Senate Report No. 1979, 82nd Congress, 2nd Session, June 27, 1952, *U.S. Code Cong. & Adm. News* 2394, 2402-2403 (1952) makes this clear. The report declares that the intent behind the enactment was to codify the presumption of patent validity already voiced by the courts. At that time the nearly

---

2. Many decisions of the United States Courts of Appeals have given such an interpretation to the presumption of patent validity since enactment of 35 U.S.C. 282. *See, e.g., Ingersoll-Rand Co. v. Brunner & Lay, Inc.*, 474 F.2d 491, 496 (5th Cir. 1973), *reh. denied*, 474 F.2d 1347, *cert. denied*, 414 U.S. 865; *Hobbs v. United States Atomic Energy Commission*, 451 F.2d 849, 856 (5th Cir. 1971); *Rains v. Niaqua, Inc.*, 406 F.2d 275, 278 (2nd Cir. 1969); *Moon v. Cabot Shops, Inc.*, 270 F.2d 539, 541 (9th Cir. 1959), *cert. denied*, 361 U.S. 965; *Long v. Arkansas Foundry*, 247 F.2d 366, 369 (8th Cir. 1957). To this extent the decision rendered by the Sixth Circuit conflicts with the decisions of other circuits.

unanimous position of the courts was that the presumption of patent validity placed the burden of persuasion on the issue of validity upon the party asserting invalidity. *See, e.g., Mumm v. Jacob E. Decker & Sons*, 301 U.S. 168, 171 (1937); *Radio Corp. of America v. Radio Engineering Laboratories, Inc.*, 293 U.S. 1, 7-8 (1934); *Strong-Scott Manufacturing Co. v. Weller*, 112 F.2d 389, 394 (8th Cir. 1940).

The presumption of patent validity is based on the skill and expertise of the patent office. *Moon v. Cabot Shops, Inc.*, 270 F.2d 539, 541 (9th Cir. 1959), *cert. denied*, 361 U.S. 965. It is presumed that the patent office acted correctly in issuing letters patent. A construction such as the Sixth Circuit has given the presumption places each patent issued by that office in unreasonable jeopardy. It requires the patentee to prove his patent valid each time its validity is brought to issue. It relegates the presumption of patent validity to nothing more than a test for a directed verdict. This decision constitutes not only a substantial threat to patent holders but also to litigants in any area who enjoy an assignment of the burden of persuasion by way of a codified presumption.

2. 35 U.S.C. 282 DOES NOT PERMIT JURY INSTRUCTIONS WHICH PLACE THE BURDEN OF PROOF OF PATENT VALIDITY UPON THE PATENTEE IN A PATENT INFRINGEMENT SUIT IN THE ABSENCE OF A CLARIFYING INSTRUCTION THAT SUCH BURDEN IS MET BY THE INTRODUCTION INTO EVIDENCE OF THE DULY ISSUED PATENTS.

As previously noted, the United States District Court for the Northern District of Ohio assigned petitioner the task of proving the validity of both of his patents by a preponderance of the evidence. In explaining the phrase

"preponderance of the evidence" the District Court told the jury:

> "If the evidence is equally balanced, or in equipoise, or if you are unable to determine which side of an issue has the preponderance then the party who has the burden of proof has not established such issue by a preponderance of the evidence."

While the District Court did instruct the jury that the patents in question were presumed valid, it did so only in reference to respondent's burden of proving invalidity. Not once in its charge did the court even mention the effect which the presumption of validity had upon the burden of proof originally assigned petitioner.

Petitioner's counsel requested an explanatory instruction that the presumption of validity arising from the issuance of the patents by the patent office carried petitioner's burden of proof on validity in the absence of clear and convincing evidence on behalf of respondent that the patents were invalid. Such requested instruction was refused by the court.

In essence the jurors were given two opposite instructions. They were told that petitioner had the burden of proving that his patents were valid and that if the evidence were equally balanced the jurors must find against petitioner on that issue. They were also told that respondent must prove that the patents were invalid by clear and convincing evidence. The jurors were assigned the impossible task of weighing the evidence in accordance with two conflicting standards of proof. The judge's instruction on the presumption of validity did not retract either of these burdens nor did it explain the apparent inconsistencies.

On appeal the Sixth Circuit sanctioned the charge given by the District Court. The Court of Appeals apparently ignored the charge's inconsistencies and boldly asserted that "plaintiff had the burden of proving the validity of his patent." Again the court denied 35 U.S.C. 282 its intended effect.

As shown before, Congress by 35 U.S.C. 282 has placed the burden of proof, in the sense of the risk of nonpersuasion, on the issue of patent validity upon the party asserting invalidity. Such burden cannot be given effect when the patentee is given an opposite burden of persuasion upon the same issue.[3] If any burden at all can consistently with 35 U.S.C. 282 be placed upon the patentee on the issue of validity it is only the burden of introducing his letters patent into evidence. Any other burden wrongfully assigned to the patentee must be clearly and unequivocally retracted.

The requested clarifying instruction was an attempt to correct and add consistency to the court's charge. Petitioner was wrongfully assigned the burden of persuading the jury by a preponderance of the evidence that his patents were valid. Such an error cannot be rectified solely by assigning a new and opposite burden of persuasion to the other party upon the same issue.

The instruction required was one which unequivocally informed the jury that petitioner was not required to persuade them by a preponderance of the evidence that the patents were valid, but rather his only burden was to introduce the patents into evidence. It was solely respondent's burden to persuade the jury that the patents

---

3. The effect of such an instruction is simply to confuse the jury and to allow its verdict to stand on an improper rule of proof. For example if the evidence were equally balanced the verdict would turn upon which burden the jury in its confusion decided to apply.

were invalid. This could and would have been accomplished by an instruction that the presumption of validity carried petitioner's burden in the absence of clear and convincing evidence to the contrary. Absence of such an instruction allowed the jury to return a verdict based upon an improper rule of proof.

Several times this Court has held that confusing and misleading instructions to a jury constitute reversible error. *Henry v. Collins*, 280 U.S. 356 (1965); *Ayers v. Watson*, 113 U.S. 594 (1885). Similarly instructions which place the burden of proof upon the wrong party demand reversal. *See New York Life Insurance Co. v. Gamer*, 303 U.S. 161, 168-172 (1938). The Sixth Circuit had a clear duty to reverse the District Court for its erroneous and misleading charge. Not only did it fail to do so, but it sanctioned the error by declaring that a patentee must prove his patent valid. Again this decision constitutes a substantial and unwarranted threat to patent holders.

CONCLUSION

The Sixth Circuit has given the presumption of patent validity the function of assigning to the party asserting invalidity the mere burden of coming forth with evidence of invalidity. It has held that a patentee must prove his patent valid. These positions conflict with the clear congressional intent behind 35 U.S.C. 282 and with decisions of other United States Courts of Appeals who have interpreted 35 U.S.C. 282.[4] This Court has yet to define said statute or to resolve the conflict among the circuits.

---

4. To the extent that 35 U.S.C. 282 is based upon precodification rulings by this Court, the Sixth Circuit's decision even conflicts with this Court's prior rulings. *See, e.g., Mumm v. Jacob E. Decker & Sons, supra; Radio Corp. of America v. Radio Engineering Laboratories, Inc., supra.*

The Sixth Circuit has sanctioned a departure by a District Court from the accepted course of judicial proceedings. It has failed to reverse the District Court for assignment of two burdens of proof upon the same issue and refusal to retract the one erroneously assigned.

This Court should intervene to define the congressional intent behind 35 U.S.C. 282 and to assure that such intent is followed. It should exercise its power of supervision to correct the errors made against petitioner and to prevent repetition of those errors against others.

For the foregoing reasons, it is respectfully contended that the within petition raises questions of great public interest in the patent laws of the United States and the statutes pertaining thereto. Therefore, this petition should be granted.

Respectfully submitted,

PAUL A. WEICK, ESQUIRE
WEICK & GENOVESE CO., L.P.A.
800 Centran Building
Akron, Ohio 44308
Counsel for Petitioner

APPENDIX A

Opinion of the Court of Appeals

(Filed July 3, 1975)

No. 74-2063

UNITED STATES COURT OF APPEALS
FOR THE SIXTH CIRCUIT

LAWRENCE R. SPERBERG,
Plaintiff-Appellant,

v.

GOODYEAR TIRE & RUBBER COMPANY,
Defendant-Appellee.

APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF OHIO

Before: PECK, McCREE and LIVELY, *Circuit Judges.*

LIVELY, Circuit Judge. In this action the plaintiff sought damages for the defendant's alleged infringement of two method or process patents. One of the patents claimed discovery or invention of "a worthwhile non-destructive method or process of performing tire tests to determine useful tire life," while the other claimed discovery or invention of "a worthwhile non-destructive method or process of performing tire tests to determine wear susceptibility of tires." The plaintiff had originally filed suit as a class action alleging infringement by a large number of tire manufacturers. After the district court refused to certify the class action, the plaintiff filed sepa-

rate actions against the five largest tire companies in the country. One of these companies, Uniroyal, was dismissed for lack of venue.

The plaintiff and the defendants in the four pending cases in the district court then entered into a stipulation by which it was agreed that the case against Goodyear would be tried first to a jury and that the plaintiff and each of the four defendants—the Goodyear Tire and Rubber Company, the Firestone Tire and Rubber Company, the General Tire and Rubber Company and B. F. Goodrich Company—would be bound by the judgment in the Goodyear case on the issue of validity or enforceability of the patents. Firestone also agreed to be bound by the judgment in the Goodyear case on the issue of infringement, but the other two defendants would be entitled to separate trials on this issue. Thereafter, Goodyear moved the court to enter an order "restraining the parties and their counsel from making reference to the pendency of other related cases and from informing the jury of the content, substance or spirit . . ." of the stipulation previously entered into. Goodyear filed a brief with its motion, pointing out that the trial court has broad discretion in the admission or rejection of evidence which might be prejudicial. Goodyear argued that the defendants in the other cases would not be represented at the Goodyear trial and that they might easily be prejudiced by references to the plaintiff's pending cases against them.

The court held a hearing on the motion at which plaintiff's counsel made the following argument:

> Now, I think the jury is entitled to know the circumstances which pertain to this particular case. I think to put the jury into isolation and say you can only know that there is Goodyear here when, in fact, Goodyear, as well as Firestone, are completely bound

> by this trial, as well as General and Goodrich with respect to the interwoven issue of validity. I think it is important that the jury know what they are actually trying and not live in a vacuum created without that kind of knowledge that any other member of the public knows.
>
> We have gone through the entire discovery in this case. It is a consolidated case. We have all dealt with it with all defendants being real and present, and I think it is wholly illusory to put the matter to the jury on just the matter of Goodyear's presence.
>
> I have serious question whether the plaintiffs would get a fair trial under those circumstances.
>
> The Court: Well, as I say, my inclination is to grant the motion, and in the event that you fail to convince me to the contrary by some authority, your exceptions will be noted, Mr. Marshall.

The plaintiff did not submit any authorities to the court on the subject or advise the court of any bases for his objection other than the statement quoted above.

So far as the record shows, the order in question was invoked only twice during the trial. During the opening statement by counsel for Goodyear, the court, without an objection or motion by the parties, cautioned attorneys not to refer to any other tire companies. Shortly thereafter counsel for Goodyear requested a clarification of the scope of the order "vis-a-vis the mentioning of other rubber companies." He pointed out that the primary witness for Goodyear, Mr. Robert Dunlop, had worked for Goodrich for nine years and that items of prior art had been developed by people from various other tire companies. The court then ruled that such evidence would be admissible

"without referring directly, indirectly, or inferring that there is other outstanding litigation concerning this same patent as against those companies.

That is the scope of the order."

On appeal, Sperberg refers to the order as a "gag rule" and asserts that the application of this order by the district court denied him a fair trial. Specifically it is claimed that because of this rule, Sperberg was unable to get before the jury the substantial basis for a finding that the witness Dunlop was biased in favor of Goodyear. Dunlop was presented as an expert witness, and it was shown upon direct examination that he had worked for B. F. Goodrich for nearly ten years and for General Tire for approximately two years. He testified that after leaving General Tire he became an independent consulting engineer, specializing in tire development and manufacturing problems and that since 1955 he had operated Smithers Laboratories, an independent testing organization. He stated that he had testified in court 50 or 60 times, mostly in product liability cases, both for and against tire companies, and that he had appeared as a witness in one other patent case. He testified as an expert that he could find no correlation between the durability or wear susceptibility of tires and the presence of "force variation," which was diametrically opposed to the major thesis of Sperberg's two patents involved in the case. This was undoubtedly the most persuasive testimony in the case in support of Goodyear's claim that neither patent was valid.

Cross-examination of Dunlop fills approximately 200 pages of the transcript. It was brought out that he had testified on behalf of Goodyear in some of his previous court appearances and that he had appeared for Firestone in the patent case mentioned in his testimony on direct

examination. The witness then testified that the gross receipts of Smithers Laboratories were approximately $1,000,000 per year and that he was the owner of 45 to 50 percent of the company. He further estimated that Smithers did $15,000 to $20,000 per year of business with Goodyear and that 35 percent of all of its business was done with tire companies in this country. In his reply brief, Sperberg concedes that the witness Dunlop could have been questioned further about his relationships with various other companies in the American tire industry, but claims this would have been meaningless to the jury without knowledge that three other tire companies were vitally interested in the outcome of this litigation. It is claimed that plaintiff was denied his right to let the jury know the identity of the real parties in interest and his related right to develop the bias of Dunlop as the primary witness for the defense, since the rule in question made effective cross-examination of Dunlop impossible. At no time was this basis for the plaintiff's objection to the order stated to the trial judge.

The Sixth Amendment guarantee of the right to confrontation of witnesses requires an opportunity for cross-examination of all prosecution witnesses in criminal cases. The chief purpose of such cross-examination is frequently to show bias or unreliability. In *Alford v. United States*, 282 U.S. 687 (1931), the Supreme Court held that it was an abuse of discretion to limit cross-examination by an order *in limine* that prevented an inquiry designed to show that testimony of a witness was either untrue or biased. More recently the Supreme Court has held that the partiality or bias of a witness is always relevant and that a court may not restrict cross-examination whose purpose is to show the reason for bias or lack of credibility of a witness. The Court found that the partial cross-examination

which had been permitted on the subject of bias was not sufficient since the cross-examining party is entitled to a meaningful inquiry which will disclose to the jury all possible facts upon which the jury may legitimately draw to reach an inference of bias or unreliability. *Davis v. Alaska*, 415 U.S. 308 (1974).

In *Majestic v. Louisville and Nashville Railroad Company*, 147 F.2d 621, 627 (6th Cir. 1945), this court held that all facts and circumstances which tend to show bias or interest in litigation by a witness may properly be developed on cross-examination. In this civil case the court referred to the "undoubted right of a party to cross examine witnesses to show their interest or bias." *Id.* at 627. In *Ferber Corp. v. Fairchild Motor Co.*, 269 F.2d 841 (5th Cir. 1959), the court by order kept from the jury in a patent case the fact that a third party had entered into an agreement with one of the defendants by which the third party would assist in the defense and share the expense of the law suit. Objection was made to the order excluding this information from the jury, and it was held that the objection made at the time of entry of the order was sufficient to preserve the issue for appellate review. Subsequently, the defendant introduced two witnesses, one of whom was a consultant to the undisclosed interested party and the other an employee of that party. The court of appeals reversed for a new trial, holding that the effect of exclusion of information of possible bias and interest of two witnesses for the defendant could not be fully evaluated since it would be impossible to know how the jury would have reacted to this information. The court found that it was impossible to hold that substantial rights of the plaintiff had not been affected by the order or that it was harmless error. *Id.* at 844.

Without questioning the established principles set forth in the foregoing cases, Goodyear points out that the plaintiff did extensively cross-examine the witness Dunlop and that the jury learned that he had previously worked for Goodrich and General Tire, two of the three un-named parties. Likewise, the testimony disclosed that he had testified on behalf of all tire companies, including Firestone, the third un-named party, and Goodyear. More significantly, the extent of the dependence by Smithers Laboratories on the American tire industry was disclosed to the jury. Thus it is argued that the jury had all of the information necessary for it to determine whether or not Dunlop was a biased witness. Goodyear relies upon the decision in *Kanatser v. Chrysler Corp.*, 199 F.2d 610 (10th Cir. 1952), in which Judge Murrah held that the trial judge has broad discretion in determining the scope of cross-examination and that where the possible interest of a witness in the outcome of a trial is clear to the jury from the cross-examination permitted, it is not an abuse of discretion to limit the extent and scope of such cross-examination.

Goodyear further maintains that the purpose of the order prohibiting reference to the three pending cases was to keep extraneous issues out of the trial of the Goodyear case and that the court was justified in excluding evidence on collateral matters, the introduction of which would have lengthened the trial, confused the issues and possibly misled the jury. *Olin-Mathieson Chemical Corp. v. Allis-Chalmers Manufacturing Co.*, 438 F.2d 833 (6th Cir. 1971). In the *Olin-Mathieson* case this court cited the then proposed rules of evidence, specifically proposed Rule 4-03, which has been modified and adopted effective July 1, 1975 as Rule 403, providing as follows:

> Although relevant, evidence may be excluded if its probative value is substantially outweighed by the danger of unfair prejudice, confusion of the issues, or misleading the jury, or by considerations of undue delay, waste of time, or needless presentation of cumulative evidence.

Orders *in limine* which exclude broad categories of evidence should rarely be employed. A better practice is to deal with questions of admissibility of evidence as they arise. In the present case the plaintiff made no attempt to require the witness Dunlop to answer further questions about his relations with the companies involved in the three pending suits, saying that he was prevented from doing so by the standing order. In the absence of such an order, plaintiff would have been required to present the issue in the specific context of cross-examination of this witness and obtain a ruling from the court either requiring or excusing the witness from answering particular questions or a particular line of questioning.

As the record stands before this court, however, the plaintiff never made known to the district court his claim that he was being denied a fair trial because his right to fully cross-examine the witness Dunlop was prevented by the order of the court. At the very time that the court was requested to define the scope of the order, counsel for Goodyear pointed out that Mr. Dunlop would be the primary witness for Goodyear and that there might be a problem with the rule since Mr. Dunlop had previously worked for Goodrich. During this discussion between court and counsel, the attorneys for plaintiff made no further objection to the order and did not relate the order to any anticipated problem in cross-examining the witness Dunlop. Under these circumstances, and in view of the extensive cross-examination which elicited information

from which the jury might infer bias and interest on the part of Dunlop, we find no abuse of discretion. *Kanatser v. Chrysler Corp., supra.* If counsel felt that plaintiff was being denied a fair trial because of limitations on cross-examination it was their obligation to present this matter to the trial court and obtain a specific ruling on this claim of error. Rule 46, Fed. R. Civ. P. We note also that in his motion for a new trial the plaintiff did not acquaint the trial court with his present claim that the court's order so limited cross-examination as to deny him a fair trial.

As his second ground for reversal the plaintiff states that "the court committed prejudicial error in failing to give additional instructions to the jury as requested by Sperberg." The district court instructed the jury on the plaintiff's burden to prove three material elements of validity of each patent. It then charged the jury on presumptions generally and followed this with a specific instruction that "the law presumes the patents here in question to be valid, in the absence of clear and convincing evidence to the contrary; presumes further that the Patent Office acted correctly in issuing the patents." At a later point in the charge the court again instructed that the issuance of a patent raises the presumption that the patent is valid and explained that the presumption of validity "is merely a rule of evidence which places the burden upon one who disputes the validity of a patent to come forward with clear and convincing evidence that the Patent Office acted erroneously . . ." in issuing the patent. Finally the court instructed: "If, however, it be your conclusion that the defendant has failed to prove by clear and convincing evidence one or more of its affirmative assertions of invalidity as to all claims of one or both of said patents, then, in that event you shall find one or both of said patents to be valid and you will proceed to deter-

mine if the defendant infringed one or both of the patents you herein found to be valid."

The plaintiff argues that these instructions are correct as far as they go, but that the court "should have instructed the jury that the issuance of the patent was cogent evidence from which a presumption arises, that, by itself, carries Sperberg's burden of proof as to validity in the absence of clear and convincing evidence to the contrary."

We have read the court's entire charge to the jury and believe it correctly presented the issues with respect to validity of the patents. There is no reason to believe that the jury was in any way confused as to the burden of proof in this case. The fact is that the plaintiff had the burden of proving the validity of his patent. The issuance of letters by the Patent Office, because of the statutory presumption of validity, makes a *prima facie* case for a plaintiff asserting the validity of his patent. This presumption has no independent evidentiary value, however, but only serves to place the burden of proof on a party who asserts invalidity. *Rains v. Niaqua, Inc.*, 406 F.2d 275, 278 (2d Cir. 1969). As the Supreme Court pointed out in *Del Vecchio v. Bowers*, 296 U.S. 280 (1935), a statutory presumption "falls out of a case" when the party against whom the presumption works meets his burden of offering evidence sufficient to justify a contrary finding. *Id.* at 286. We find no basis for believing that the jury in this case understood the instructions on validity to mean anything other than that the plaintiff entered the case with a presumption that both patents were valid and that the jury could only find them invalid if the defendant introduced clear and convincing evidence of invalidity. Since neither party questioned the "clear and convincing" standard of proof applied by the district court we do not reach the question in this case of whether or not

this is the proper standard to be applied where a claim of invalidity is based on alleged obviousness.

The plaintiff also complains that the trial court ordered a separation of witnesses at the beginning of his rebuttal without requiring such separation in the earlier stages of the trial. Neither party requested that the witnesses be separated at the beginning of the trial. However, as plaintiff called his first rebuttal witness, counsel for Goodyear moved the court to require a separation of the rebuttal witnesses. The court granted the motion and the plaintiff presented three witnesses thereafter. The plaintiff recognizes that the trial court has broad discretion in determining whether to order the exclusion of witnesses from the courtroom, but asserts that under the circumstances of this case it was an abuse of discretion to apply this rule only to his rebuttal witnesses. Of course, plaintiff could have requested such an order for the defendant's witnesses and did not do so. There is no federal rule requiring that a request for separation of witnesses be made at any particular stage of a trial. We find no abuse of discretion in the determination by the trial judge that Goodyear's motion for separation of rebuttal witnesses should be granted. The cases cited by the plaintiff, *Powell v. United States*, 208 F.2d 618 (6th Cir. 1953), and *Kaufman v. United States*, 163 F.2d 404 (6th Cir. 1947), state the general rule that such a trial order will be reversed only for abuse of discretion but do not support plaintiff's argument that there was an abuse of discretion in the instant case.

The final issue on appeal is whether the court committed prejudicial error in submitting interrogatories to the jury "which comprised mixed questions of law and fact." The plaintiff consistently opposed the submission of interrogatories to the jury on the ground that the is-

sues were so complicated that the jury would be confused by the interrogatories. The very fact of complicated issues is probably the reason that so few patent cases are tried before juries. Nevertheless, it was the plaintiff who requested the jury in this case, and the court was required to submit the issues to the jury in such a manner as to ascertain whether the jury had properly applied the law given in the instructions to its specific findings. The instructions which the jury received were quite comprehensive and contained an accurate statement of the law applicable to the issues in this case. In fact, the only objection to the instructions by the plaintiff concerned the burden-of-proof question previously dealt with in this opinion. Otherwise, the court's charge appears to have satisfied the plaintiff.

Careful comparison of the court's instructions with the interrogatories submitted to the jury reveals that the court instructed the jury as to the governing law with respect to each question propounded in interrogatories 1 through 18. Following interrogatory #18 the court then directed the jury to examine its answers to certain interrogatories, and to state, in accordance with specific instructions on the effect of such answers, whether it found each of the patents to be valid or invalid. The jury responded, correctly following the court's directions, that each of the patents was invalid. It was not necessary for the jury to answer interrogatories 19 and 20 since they applied only in the event that either or both of the patents should have been found valid. Nevertheless, the jury did answer these interrogatories and indicated that neither of the patents had been infringed. It is clear that interrogatories 1 through 18 required the jury to make only factual determinations. The two un-numbered interrogatories between numbers 18 and 19 required the jury to answer the ultimate question of validity of each of the patents, but the jury was not permitted to reach this answer independently of its findings. These questions merely required the jury to canvass its previous answers and to make the ultimate finding which the law requires on the basis of these factual findings. The answers to these interrogatories were actually surplusage. The general verdict of the jury in favor of Goodyear was consistent with the answers to the factual questions contained in interrogatories 1 through 18 and the court would have been required to enter judgment for the defendant thereon. Rule 49(b) Fed. R. Civ. P.

Plaintiff insists that it was reversible error to submit the interrogatories in this case because they contained mixed questions of law and fact. In *Carpenter v. Baltimore and Ohio Railroad Company*, 109 F.2d 375 (6th Cir. 1940), we held that interrogatories must submit to the jury only factual questions from which legal propositions may be deduced and that it is improper to pose questions of law or mixed questions of fact and law in interrogatories. We do not believe that the *Carpenter* decision means that it is improper under all circumstances to submit mixed questions of law and fact to a jury. Rule 49(b) provides that when a jury is required to render a general verdict accompanied by answers to interrogatories "[t]he court shall give such explanation on instruction as may be necessary to enable the jury both to make answers to the interrogatories and to render a general verdict . . . ." In *Kissell v. Westinghouse Electric Corp.*, 367 F.2d 375, 376 (1st Cir. 1966), the court, in discussing *Carpenter v. Baltimore and Ohio Railroad Company, supra*, said, "It would be a purposeless restriction to say that special interrogatories cannot be mixed questions of law and fact, provided that the jury is properly instructed as to the law." Similarly, in *Merchant's Fast Motor Lines, Inc. v. Lane*, 259 F.2d

336, 338 (5th Cir. 1958), it was held that mixed questions of law and fact may be submitted "only if the jury is instructed as to the legal standards which they are to apply. *Jackson v. King*, 5th Cir., 1955, 223 F.2d 714, 718." The trial court has broad discretion in determining the form and content of interrogatories to the jury under Rule 49(b). *Tennessee Consolidated Coal Co. v. United Mine Workers of America*, 416 F.2d 1192, 1200 (6th Cir. 1969). Finding as we do that interrogatories 1 through 18 required purely factual findings by the jury and that the court adequately instructed the jury with respect to its answers to the interrogatories containing questions of law, we find no prejudicial error in the procedure adopted by the trial court.

The judgment of the district court is affirmed.

APPENDIX B

Judgment of the Court of Appeals

(Filed July 3, 1975)

No. 74-2063

UNITED STATES COURT OF APPEALS
FOR THE SIXTH CIRCUIT

LAWRENCE R. SPERBERG,
Plaintiff-Appellant,

v.

GOODYEAR TIRE & RUBBER COMPANY,
Defendant-Appellee.

Before: PECK, McCREE and LIVELY, *Circuit Judges.*

APPEAL from the United States District Court for the Northern District of Ohio.

THIS CAUSE came on to be heard on the record from the United States District Court for the Northern District of Ohio and was argued by counsel.

ON CONSIDERATION WHEREOF, It is now here ordered and adjudged by this Court that the judgment of the said District Court in this cause be and the same is hereby affirmed.

It is further ordered that Defendant-Appellee recover from Plaintiff-Appellant the costs on appeal, as itemized below, and that execution therefor issue out of said District Court if necessary.

Entered by Order of the Court.

JOHN P. HEHMAN, *Clerk*
By /s/ GRACE KELLER
Chief Deputy

APPENDIX C

Judgment of the Court of Appeals

(Filed July 3, 1975)

No. 74-2064

UNITED STATES COURT OF APPEALS
FOR THE SIXTH CIRCUIT

LAWRENCE R. SPERBERG,
Plaintiff-Appellant,

v.

FIRESTONE TIRE & RUBBER COMPANY,
Defendant-Appellee.

Before: PECK, MCCREE and LIVELY, *Circuit Judges.*

APPEAL from the United States District Court for the Northern District of Ohio.

THIS CAUSE came on to be heard on the record from the United States District Court for the Northern District of Ohio.

ON CONSIDERATION WHEREOF, It is now here ordered and adjudged by this Court that the judgment of the said District Court in this cause be and the same is hereby affirmed.

It is further ordered that Defendant-Appellee recover from Plaintiff-Appellant the costs on appeal, as itemized below, and that execution therefor issue out of said District Court if necessary.

Entered by Order of the Court.

JOHN P. HEHMAN, *Clerk*
By /s/ GRACE KELLER
Chief Deputy

APPENDIX D

Judgment of the Court of Appeals

(Filed July 3, 1975)

No. 74-2065

UNITED STATES COURT OF APPEALS
FOR THE SIXTH CIRCUIT

LAWRENCE R. SPERBERG,
Plaintiff-Appellant,

v.

GENERAL TIRE & RUBBER COMPANY,
Defendant-Appellee.

Before: PECK, MCCREE and LIVELY, *Circuit Judges.*

APPEAL from the United States District Court for the Northern District of Ohio.

THIS CAUSE came on to be heard on the record from the United States District Court for the Northern District of Ohio.

ON CONSIDERATION WHEREOF, It is now here ordered and adjudged by this Court that the judgment of the said District Court in this cause be and the same is hereby affirmed.

It is further ordered that Defendant-Appellee recover from Plaintiff-Appellant the costs on appeal, as itemized below, and that execution therefor issue out of said District Court if necessary.

Entered by Order of the Court.

JOHN P. HEHMAN, *Clerk*
By /s/ GRACE KELLER
Chief Deputy

APPENDIX E

Judgment of the Court of Appeals

(Filed July 3, 1975)

No. 74-2066

UNITED STATES COURT OF APPEALS
FOR THE SIXTH CIRCUIT

LAWRENCE R. SPERBERG,
Plaintiff-Appellant,

v.

B. F. GOODRICH COMPANY,
Defendant-Appellee.

Before: PECK, MCCREE and LIVELY, *Circuit Judges.*

APPEAL from the United States District Court for the Northern District of Ohio.

THIS CAUSE came on to be heard on the record from the United States District Court for the Northern District of Ohio.

ON CONSIDERATION WHEREOF, It is now here ordered and adjudged by this Court that the judgment of the said District Court in this cause be and the same is hereby affirmed.

It is further ordered that Defendant-Appellee recover from Plaintiff-Appellant the costs on appeal, as itemized below, and that execution therefor issue out of said District Court if necessary.

Entered by Order of the Court.

JOHN P. HEHMAN, *Clerk*
By /s/ GRACE KELLER
Chief Deputy

APPENDIX F

Order of the Court of Appeals

(Filed November 18, 1974)

Nos. 74-2063, 74-2064, 74-2065 & 74-2066

UNITED STATES COURT OF APPEALS
FOR THE SIXTH CIRCUIT

LAWRENCE R. SPERBERG,
Plaintiff-Appellant,

v.

THE GOODYEAR TIRE & RUBBER COMPANY,
Defendant-Appellee.

LAWRENCE R. SPERBERG,
Plaintiff-Appellant,

v.

THE FIRESTONE TIRE & RUBBER COMPANY,
Defendant-Appellee.

LAWRENCE R. SPERBERG,
Plaintiff-Appellant,

v.

THE GENERAL TIRE & RUBBER COMPANY,
Defendant-Appellee.

LAWRENCE R. SPERBERG,
Plaintiff-Appellant,

v.

B. F. GOODRICH COMPANY,
Defendant-Appellee.

Upon consideration of the Plaintiff-Appellant's motion to consolidate the appeal herein and further consider-

ing the joint statement and request of parties Defendant-Appellee in response thereto,

IT IS ORDERED that the motion be and it hereby is denied.

IT IS FURTHER ORDERED that consistent with the stipulation filed in the District Court on February 28, 1974, the Plaintiff-Appellant and the respective Defendant-Appellee in each of the appeals 74-2064, 74-2065 and 74-2066 shall be bound by this Court's decision on the issue of validity or enforceability of the patents in suit as a consequence of the appeal in 74-2063, subject to all rights of appeal, and Plaintiff-Appellant and Defendant-Appellee in 74-2064 shall be bound by this Court's decision on the issue of infringement of the patents in suit (exclusive of the amount of damages) as a consequence of said appeal No. 74-2063 subject to all rights of appeal, and upon the determination of said appeal No. 74-2063, this Court, in accordance with the foregoing, will enter appropriate judgments in said appeals Nos. 74-2064, 74-2065 and 74-2066. Accordingly, no briefs shall be required to be filed and no oral argument shall be permitted in appeals Nos. 74-2064, 74-2065 and 74-2066.

Entered by Order of the Court.

/s/ JOHN P. HEHMAN
Clerk

APPENDIX G

Judgment of the District Court

(Filed April 25, 1974)

Civil Action File No. C73-801

UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF OHIO
EASTERN DIVISION

LAWRENCE R. SPERBERG,

vs.

GOODYEAR TIRE & RUBBER CO.

This action came on for trial before the Court and a jury, Honorable Robert B. Krupansky, United States District Judge, presiding and the issues having been duly tried and the jury having duly rendered its verdict,

It is Ordered and Adjudged that the complaint herein is hereby dismissed at plaintiff's costs.

Dated at Cleveland, Ohio, this 25th day of April, 1974.

/s/ ROBERT B. KRUPANSKY
United States District Judge

APPENDIX H

Order of the District Court

(Filed April 30, 1974)

No. C73-802

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF OHIO
EASTERN DIVISION

LAWRENCE R. SPERBERG,
Plaintiff,

vs.

THE FIRESTONE TIRE & RUBBER COMPANY,
Defendant.

KRUPANSKY, *J.*:

Upon a verdict for the defendant in Case No. C73-801, Lawrence R. Sperberg vs. The Goodyear Tire & Rubber Company, and a finding by the Jury therein by Special Interrogatories that the patents in suit in C73-801 are invalid,

IT IS ORDERED that, in accordance with the Stipulation & Order filed in this case on Feb. 28, 1974, the complaint herein is dismissed at plaintiff's costs, subject to all rights of appeal.

/s/ ROBERT B. KRUPANSKY
United States District Judge

APPENDIX I

Order of the District Court

(Filed April 30, 1974)

No. C73-803

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF OHIO
EASTERN DIVISION

LAWRENCE R. SPERBERG,
Plaintiff,

vs.

THE GENERAL TIRE & RUBBER CO.,
Defendant.

KRUPANSKY, *J.*:

Upon a verdict for the defendant in Case No. C73-801, Lawrence R. Sperberg vs. The Goodyear Tire & Rubber Company, and a finding by the Jury therein by Special Interrogatories that the patents in suit in C73-801 are invalid,

IT IS ORDERED that, in accordance with the Stipulation & Order filed in this case on Feb. 28, 1974, the complaint herein is dismissed at plaintiff's costs, subject to all rights of appeal.

/s/ ROBERT B. KRUPANSKY
United States District Judge

APPENDIX J

Order of the District Court

(Filed April 30, 1974)

No. C73-804

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF OHIO
EASTERN DIVISION

LAWRENCE R. SPERBERG,
Plaintiff,

vs.

B. F. GOODRICH CO.,
Defendant.

KRUPANSKY, *J.*:

Upon a verdict for the defendant in Case No. C73-801, Lawrence R. Sperberg vs. The Goodyear Tire & Rubber Company, and a finding by the Jury therein by Special Interrogatories that the patents in suit in C73-801 are invalid,

IT IS ORDERED that, in accordance with the Stipulation & Order filed in this case on Feb. 28, 1974, the complaint herein is dismissed at plaintiff's costs, subject to all rights of appeal.

/s/ ROBERT B. KRUPANSKY
United States District Judge

APPENDIX K

Order of the District Court

(Filed May 22, 1974)

Civil Action Nos. C73-801, C73-802, C73-803 & C73-804

THE UNITED STATES DISTRICT COURT
THE NORTHERN DISTRICT OF OHIO
EASTERN DIVISION

LAWRENCE R. SPERBERG
Plaintiff
v.
THE GOODYEAR TIRE & RUBBER CO.
and
THE FIRESTONE TIRE & RUBBER CO.
and
THE GENERAL TIRE & RUBBER CO.
and
B. F. GOODRICH COMPANY
Defendants

KRUPANSKY, *J.*

Upon consideration of plaintiff's Motion for a New Trial, and, in the alternative for amendment of judgments, the Court finds:

1. The general verdict and accompanying interrogatories are consistent, and supported by the clear weight of the evidence. Rule 59, Fed. R. Civ. P.

2. Defendants are entitled to costs pursuant to Rule 54(d), Fed. R. Civ. P., and the judgments are, accordingly, correct under the law.

Accordingly, plaintiff's Motion is hereby denied.

IT IS SO ORDERED.

/s/ ROBERT B. KRUPANSKY
United States District Judge

APPENDIX L

35 USC § 282. Presumption of validity; defenses

A patent shall be presumed valid. Each claim of a patent (whether in independent or dependent form) shall be presumed valid independently of the validity of other claims; dependent claims shall be presumed valid even though dependent upon an invalid claim. The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting it.

The following shall be defenses in any action involving the validity or infringement of a patent and shall be pleaded:

(1) Noninfringement, absence of liability for infringement or unenforceability,

(2) Invalidity of the patent or any claim in suit on any ground specified in part II of this title as a condition for patentability,

(3) Invalidity of the patent or any claim in suit for failure to comply with any requirement of sections 112 or 251 of this title,

(4) Any other fact or act made a defense by this title.

In actions involving the validity or infringement of a patent the party asserting invalidity or noninfringement shall give notice in the pleadings or otherwise in writing to the adverse party at least thirty days before the trial, of the country, number, date, and name of the patentee of any patent, the title, date, and page numbers of any publication to be relied upon as anticipation of the patent in suit or, except in actions in the United States Court of Claims, as showing the state of the art, and the name and address of any person who may be relied upon as the prior inventor or as having prior knowledge of or as having previously used or offered for sale the invention of the patent in suit. In the absence of such notice proof of the said matters may not be made at the trial except on such terms as the court requires. As amended July 24, 1965, Pub.L. 89-83, § 10, 79 Stat. 261.

APPENDIX M

Act of March 3, 1897, ch. 391, sec. 2, 29 Stat. 692 (repealed 1952). Pleading and proof in actions for infringement

In any action for infringement the defendant may plead the general issue, and, having given notice in writing to the plaintiff or his attorney thirty days before, may prove on trial any one or more of the following special matters:

First. That for the purpose of deceiving the public the description and specification filed by the patentee in

the Patent Office was made to contain less than the whole truth relative to his invention or discovery, or more than is necessary to produce the desired effect; or,

Second. That he had surreptitiously or unjustly obtained the patent for that which was in fact invented by another, who was using reasonable diligence in adapting and perfecting the same; or,

Third. That it has been patented or described in some printed publication prior to his supposed invention or discovery thereof, or more than one year prior to his application for a patent therefor; or,

Fourth. That he was not the original and first inventor or discoverer of any material and substantial part of the thing patented; or,

Fifth. That it had been in public use or on sale in this country for more than one year before his application for a patent, or had been abandoned to the public.

And in notices as to proof of previous invention, knowledge, or use of the thing patented, the defendant shall state the names of the patentees and the dates of their patents, and when granted, and the names and residences of the persons alleged to have invented or to have had the prior knowledge of the thing patented, and where and by whom it had been used; and if any one or more of the special matters alleged shall be found for the defendant, judgment shall be rendered for him with costs. And the like defenses may be pleaded in any suit in equity for relief against an alleged infringement; and proofs of the same may be given upon like notice in the answer of the defendant, and with the like effect.

APPENDIX N

Federal Rules of Evidence Rule 301.

Presumptions in General Civil Actions and Proceedings

In all civil actions and proceedings not otherwise provided for by Act of Congress or by these rules, a presumption imposes on the party against whom it is directed the burden of going forward with evidence to rebut or meet the presumption, but does not shift to such party the burden of proof in the sense of the risk of nonpersuasion, which remains throughout the trial upon the party on whom it was originally cast.

Supreme Court, U. S.
FILED
OCT 31 1975
MICHAEL RODAK, JR., CLERK

Supreme Court of the United States

October Term, 1975

No. 75-489

LAWRENCE R. SPERBERG,

Petitioner,

vs.

THE GOODYEAR TIRE & RUBBER COMPANY, THE FIRESTONE TIRE & RUBBER COMPANY, THE GENERAL TIRE & RUBBER COMPANY and B. F. GOODRICH COMPANY,

Respondents.

BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

HUGH A. CHAPIN,
ARTHUR D. GRAY,
Kenyon & Kenyon Reilly Carr & Chapin,
59 Maiden Lane,
New York, New York 10038
Counsel for Respondent,
The Goodyear Tire & Rubber Company.

Of Counsel:

FORD W. BRUNNER
M. WILLIAM GOODWIN
The Goodyear Tire & Rubber Company,
1144 East Market Street,
Akron, Ohio 44316.

TABLE OF CONTENTS

		PAGE
I.	Introductory Statement	1
II.	Counterstatement of the Case	1
III.	Argument	3
	A. There Is No Merit In The Issue Presented By Sperberg	3
	B. The Issue Raised By The Petition Does Not Merit Review By This Court	6
IV.	Conclusion	7

TABLE OF AUTHORITIES

Cases:

Magnum Import Co. v. *Coty*, 262 U.S. 159 (1923) 6, 7

Sperberg v. *The Goodyear Tire & Rubber Co.*, —— F.2d ——, 186 U.S.P.Q. 453 (6 Cir. 1975) 5

Statutes and Rules:

35 U.S.C. § 282 ..... 2, 3

F.R. Civ. P., Rule 49(b) 2

Rule 19, United States Supreme Court Rules 6, 8

Other Authorities:

American Law Institute Model Code of Evidence 3

Address by Chief Justice Vinson, American Bar Association Meeting of September 7, 1949, 69 S. Ct. v. 6

Supreme Court of the United States

October Term, 1975

No. 75-489

LAWRENCE R. SPERBERG,

Petitioner,

vs.

THE GOODYEAR TIRE & RUBBER COMPANY, THE FIRESTONE TIRE & RUBBER COMPANY, THE GENERAL TIRE & RUBBER COMPANY and B. F. GOODRICH COMPANY,

Respondents.

BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

I.

Introductory Statement.

Respondent, The Goodyear Tire & Rubber Company, respectfully submits this brief in opposition to the Petition of Lawrence R. Sperberg for writ of certiorari to the United States Court of Appeals for the Sixth Circuit.

II.

Counterstatement of the Case.

This is a patent case resulting from four actions brought by petitioner alleging infringement of two patents by the four respondents herein. In the interest of judicial econ-

omy, by stipulation of the petitioner and all respondents, approved by the District Court and adopted by the Court of Appeals, the case was tried between petitioner, Lawrence R. Sperberg (hereinafter "Sperberg"), and one respondent, The Goodyear Tire & Rubber Company (hereinafter "Goodyear"), the petitioner and the remaining respondents agreeing to be bound by the result of that trial.*

The *Goodyear* case was tried before a jury of six which Sperberg had demanded. The trial lasted three and one half weeks and resulted in a general verdict in favor of Goodyear supported by the jury's answers to twenty interrogatories (F.R. Civ. P. 49(b)) finding both patents not infringed, and invalid on three separate grounds.

On appeal, Sperberg did not challenge the jury's resolution of the validity and infringement issues, but instead attacked the trial court's procedural handling of the trial. The appellate court found the trial court's conduct of the trial to be proper in all respects and unanimously affirmed the judgment which had been entered on the jury's verdict.

At both the trial and on the appeal, Sperberg alleged that the trial court had not given complete and accurate instructions to the jury concerning the statutory presumption of patent validity, 35 U.S.C. § 282. This contention was soundly rejected by both courts below. Sperberg now comes to this Court seeking a third consideration of this issue, which is an issue not havng any significance beyond the private interests of the parties herein and which, in any event, is totally devoid of merit.

* The remaining respondents are The Firestone Tire & Rubber Company which agreed to be bound by the decision in the *Goodyear* case as to both validity and infringement, and The General Tire Company and the B. F. Goodrich Company which agreed to be bound as to validity, reserving the right to separate trials on the issue of infringement. Since the patents were held invalid, such separate trials did not become necessary.

III.

Argument.

A. There Is No Merit In The Issue Presented By Sperberg

Sperberg's contention is that both courts below did not give proper consideration to the statutory presumption of validity, 35 U.S.C. § 282, in relation to instructing the jury concerning the respective parties' burden of proof.

The fallacy of Sperberg's position becomes apparent when one considers that the trial court went out of its way to instruct the jury concerning the presumption of validity, and if anything, gave Sperberg more than he was entitled to in instructing on the presumption.* The trial court instructed the jury as follows:

> "Presumptions are deductions or conclusions which the law requires the Jury to make under certain circumstances in the absence of evidence in the case which leads the jury to a different or contrary conclusion. A presumption continues to exist only so long as it is not overcome or outweighed by evidence in the case to the contrary; but unless and until so outweighed, the Jury should find in accordance with the presumption.
>
> "The burden of proof of the affirmative defenses directed to the invalidity of the patents herein hav-

* There is a substantial body of opinion which holds that presumptions should not be mentioned to a jury at all. See, e.g., American Law Institute Model Code of Evidence, Rule 704, Comment (b) on paragraph 2, which states:

> "A presumption, to be an efficient legal tool, must (1) be left in the hands of the judge to administer, and not be submitted to a jury for decision of the question when it is 'rebutted' or ceases to have compelling force; (2) *be so administered that the jury never hear the word presumption used since it carries unpredictable connotations to different minds;* * * *," (Emphasis added).

ing been asserted by the defendant places the burden of proof as to one or more of these assertions upon the defendant by clear and convincing evidence.

> *"In considering the defenses of invalidity, the court instructs you that the law presumes the patents here in question to be valid, in the absence of clear and convincing evidence to the contrary; presumes further that the Patent Office acted correctly in issuing the patents.*
>
> *"This presumption of validity continues in effect in favor of the plaintiff unless there is clear and convincing evidence which leads the Jury to a different or contrary conclusion."* (App. Vol. 6, pp. 1295-96).* (Emphasis added).

The trial court then instructed the jury concerning Goodyear's defenses, and in the course of those instructions, informed the jury *thirteen times* that Goodyear had the burden of proving the patents invalid by evidence which was clear and convincing.

Sperberg maintains that this was not enough and that an additional instruction should have been given to the effect that any burden Sperberg bore as to validity was *carried* by the statutory presumption of validity.

The Court of Appeals rejected Sperberg's contention, recognizing that such an instruction was not only unnecessary but would have improperly given the presumption of validity independent evidentiary value. The Court of Appeals stated:

> "The plaintiff argues that these instructions are correct as far as they go, but that the court 'should have instructed the jury that the issuance of the patent was cogent evidence from which a presumption arises, that, by itself, carries Sperberg's burden

* App. refers to the joint appendix in the Court of Appeals.

of proof as to validity in the absence of clear and convincing evidence to the contrary.'

> "We have read the court's entire charge to the jury and believe it correctly presented the issues with respect to validity of the patents. There is no reason to believe that the jury was in any way confused as to the burden of proof in this case. The fact is that the plaintiff had the burden of proving the validity of his patent. The issuance of letters by the Patent Office, because of the statutory presumption of validity, makes a *prima facie* case for a plaintiff asserting the validity of his patent. This presumption has no independent evidentiary value, however, but only serves to place the burden of proof on a party who asserts invalidity. *Rains* v. *Niaqua, Inc.* 406 F.2d 275, 278 (2 Cir. 1969). As the Supreme Court pointed out in *Del Vecchio* v. *Bowers,* 296 U.S. 280 (1935), a statutory presumption 'falls out of a case' when the party against whom the presumption works meets his burden of offering evidence sufficient to justify a contrary finding. *Id.* at 286. *We find no basis for believing that the jury in this case understood the instructions on validity to mean anything other than that the plaintiff entered the case with a presumption that both patents were valid and that the jury could only find them invalid if the defendant introduced clear and convincing evidence of invalidity."* (Court of Appeals Decision, p. 9). (Emphasis added).

Thus, with clear and unequivocal instructions in mind, the jury returned a general verdict for Goodyear and answered twenty interrogatories which were consistent with and supportive of the general verdict. The jury found both patents invalid on three separate grounds, and also found, quite apart from validity, or the presumption thereof, that neither patent had been infringed by Goodyear. It is apparent that Sperberg's assertion to this Court that the jury was

confused is totally baseless, and, in any event, certainly does not raise a question worthy of consideration by this Court.

B. The Issue Raised By The Petition Does Not Merit Review By This Court.

Rule 19 of this Court declares that, "A review on writ of certiorari is not a matter of right, but of sound judicial discretion, and will be granted only where there are special and important reasons therefor." As stated by Chief Justice Vinson in his often quoted address before the American Bar Association on September 7, 1949:

> "The Supreme Court is not, and never has been, primarily concerned with the correction of errors in lower court decisions. In almost all cases within the Court's appellate jurisdiction, the petitioner has already received one appellate review of his case . . .
>
> "The function of the Supreme Court is, therefore, to resolve conflicts of opinion on federal questions that have arisen among lower courts, to pass upon questions of wide import under the Constitution, laws and treaties of the United States, and to exercise supervisory power over lower federal courts . . .
>
> "To remain effective the Supreme Court must continue to decide only those cases which present questions whose resolution will have immediate importance far beyond the particular facts and parties involved." 69 S. Ct. v.

This Court succinctly summarized the limits of certiorari review and the general propensity of those seeking review to fail to appreciate those limits in *Magnum Import Co.* v. *Coty,* 262 U.S. 159, 163 (1923), which states:

> "The jurisdiction to bring up cases by certiorari from the Circuit Courts of Appeals was given for two purposes, first to secure uniformity of decision between

> those courts in the nine circuits, and second, to bring up cases involving questions of importance which it is in the public interest to have decided by this Court of last resort. The jurisdiction was not conferred upon this Court merely to give the defeated party in the Circuit Court of Appeals another hearing. Our experience shows that eighty per cent. (sic) of those who petition for certiorari do not appreciate these necessary limitations upon our issue of the writ."

Applying these principles, which are of even greater urgency for the overcrowded dockets of 1975 than they were in 1923 or 1949, to the present case, it is apparent that the issue presented by the petition does not raise any question of public importance, does not conflict with the decisions of this or any other court but is simply an attempt by Sperberg:

> ". . . . to give the defeated party in the Circuit Court of Appeals another hearing." *Id.*

It is difficult to conceive how instructions to a jury in an ordinary patent case dealing with a matter as routine and well-established as the statutory presumption of validity can be considered as an issue of great public importance. Most patent cases are not even tried before a jury and, thus, the issue raised by petitioner has even less general application than the host of other patent issues which are presented to this Court.

IV.

Conclusion.

The question proposed as meriting review, specifically, the effect of the statutory presumption of validity, is a question that has been fully answered by existing authority.

Application to the specific situation of this case does not present any new question and the issues here have been correctly determined by the Court of Appeals following the cited precedents. Since no special and important reasons and no substantial questions meriting review under Supreme Court Rule 19 have been presented, this petition should be denied.

Respectfully submitted,

Hugh A. Chapin
Kenyon & Kenyon Reilly
Carr & Chapin
59 Maiden Lane
New York, New York 10038
Tel. No.: (212) 425-7200

Of Counsel:

Arthur D. Gray
Kenyon & Kenyon Reilly
Carr & Chapin
59 Maiden Lane
New York, New York 10038

Ford W. Brunner
M. William Goodwin
The Goodyear Tire &
Rubber Company
1144 East Market Street
Akron, Ohio 44316